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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,967	05/29/2001	Michael Gerard Gallagher	MP/W-21927/A/AC 536	7387
324	7590	04/05/2004	EXAMINER	
CIBA SPECIALTY CHEMICALS CORPORATION			HRUSKOCI, PETER A	
PATENT DEPARTMENT			ART UNIT	
540 WHITE PLAINS RD			PAPER NUMBER	
P O BOX 2005			1724	
TARRYTOWN, NY 10591-9005			DATE MAILED: 04/05/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

<b>Office Action Summary</b>	<b>Application No.</b> 09/866,967	<b>Applicant(s)</b> GALLAGHER ET AL.	
	<b>Examiner</b> Peter A. Hruskoci	<b>Art Unit</b> 1724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 February 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5-7, 10-12 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-7, 10-12 and 16-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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Claims 16-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 16 "a solid grade polymer particles" appears to be erroneous and should be changed to - solid grade polymer particles". Claims 17 and 18 depend from claim 16.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-7, and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pearson in view of Quinn et al. and Pickering et al. Pearson disclose (see col. 3 line 10 through col. 9 line 13) a process for combining polymeric particles with dispersed particulate solids substantially as claimed. The claims differ from Pearson by reciting that the particles are added as solid grade particles, and have a specific intrinsic viscosity. Quinn et al. disclose (see col. 2 line 23 through col. 5 line 40) that it is known in the art to add solid grade particles to an aqueous liquid containing solids prior to the pumping of the liquid, to aid in separation of the solids. Pickering et al. disclose (see col. 6 line 9 through col. 8 line 45) that it is known in the art to utilize polymer flocculants having recited intrinsic viscosity to aid in dewatering mineral suspensions pumped through a flow line. It would have been obvious to one skilled in the art to modify the process of Pearson by utilizing solid grade polymeric particles having the recited intrinsic viscosity in view of the teachings of Quinn et al. and Pickering et al., to aid in dewatering the aqueous fluid. The specific particle size of the polymers and dispersed solids, would have been an obvious matter of process optimization to one skilled in the art, depending

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on the specific aqueous fluid treated and results desired, absent a sufficient showing of unexpected results.

Claim 1 properly written to include the addition of the solid grade polymer particles to the mixing chamber as recited in claim 16, would be allowable.

Applicants argue that Pearson et al. expressly demands that the polymers are added as water-in-oil emulsions, which clearly leads away from adding the polymers as solid grade water-soluble polymers as in the instant process. It is noted that the water soluble polymers in the emulsions of Pearson et al. are known in the art as flocculants, and are present in the emulsions in the form of polymer solids. It is well known in the art of liquid solid separation to add polymer flocculants in the form of solids, solutions, or emulsions in view of the teachings of Pearson et al., Pickering et al., and Quinn et al. as applied above, respectively. Furthermore, it is noted that pages 12 and 13 of the instant specification disclose that the polymers can be added as a dispersion, emulsion, or free flowing particles.

Applicants argue that Pearson et al. do not describe the use of polymers that have the recited viscosity, or that the polymers can be added during or prior to pumping the material. It is submitted that the recited viscosity is not excluded from the teachings of Pearson et al., and would appear to be included in the polymers having a molecular weight of ten million as disclosed in Pearson et al. It is further submitted that Pickering et al. was used to teach that it is known in the art to utilize polymer flocculants having the recited viscosity, to aid in dewatering mineral suspensions. Furthermore, it is noted that Pearson et al. disclose the use of a pump to mix the polymer with the material, and Pickering et al. and Quinn et al. disclose the addition of the polymer during the pumping of the material.

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Applicants allege that the advantages of the instant process as disclosed on pages 14 and 15 of the instant specification are not mentioned in Pearson et al.. It is submitted that the specific test conditions utilized to produce the advantages or results are not commensurate with the scope of the instant claims. Claim 1 properly written to include a step for forming a stack, wherein aqueous liquid is released from the rigifying aqueous material, and to include claim 10 would be allowable.

Applicants argue that the flocculation of solids as in Quinn et al. has nothing to do with the rigidification of Pearson et al.. It is submitted that addition of polymer flocculants as in Pearson et al. and the instant process would appear to cause the flocculation of solids in the material. It is further submitted that the flocculation of solids is not excluded from Pearson et al. or the instant process. Furthermore, applicants have not presented sufficient factual evidence to support the above allegation.

Applicants argue that Pickering et al. clearly teaches away from every process in which no filtration system or dewatering apparatus is used. It is submitted that the rigidification of the material and polymer as in the Pearson et al. and the instant process releases aqueous liquid from the material, and appears to dewater the material. Furthermore, Pickering et al. was used to teach that it is known in the art to utilize polymer flocculants having the recited viscosity to aid in flocculating and dewatering suspensions pumped through a flow line.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter A. Hruskoci whose telephone number is (571) 272-1160. The examiner can normally be reached on Monday through Friday from 6:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (571) 272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Peter A. Hruskoci

Primary Examiner  
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